

REMARKS

Claims 1-4 are pending in this application. By this Amendment, claim 4 is added. Support for new claim 4 can be found, for example, on page 8, lines 3-16 of the specification. Thus, no new matter is added. In view of at least the following remarks, reconsideration and allowance are respectfully requested.

The courtesies extended to Applicant's representative by Examiner Knight and Examiner Lorence at the personal interview held December 21, 2006, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

I. Rejections under 35 U.S.C. §103(a)

Claims 1 and 3 are rejected under 35 U.S.C. §103(a) over O'Neal (U.S. Patent No. 5,064,157) in view of Ueng (U.S. Patent No. 4,802,751); and claim 2 is rejected under 35 U.S.C. §103(a) over O'Neal in view of Ueng, as applied to claim 1, and further in view of Saunders, IV (U.S. Patent No. 4,700,919). These rejections are respectfully traversed.

These rejections are improper because 1) the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a); and 2) Ueng is not analogous art.

- 1) The Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

In order to establish a *prima facie* case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not

based on Applicant's disclosure. As discussed below, the Office Action has failed to satisfy the first criteria.

With respect to the first criteria, As argued in the interview, Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to modify O'Neal with the teachings of Ueng to achieve the features recited in claim 1. Specifically, Ueng teaches away from such combination.

It is "improper to combine references where the references teach way from their combination." *In re Grasselli*, 713 F.2d, 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); see also MPEP §2144 (X)(D). Further, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see also MPEP §2143.01.

As acknowledged by the Office Action, O'Neal does not disclose a crossbrace being formed at each end with a part-spherical knob, the clamps having separate elements formed with a part-spherical recess for reception of the crossbrace knob, and the respective crossbrace knob received between the part-spherical recesses of the oppositely mounted clamp elements. The Office Action further asserts that Ueng remedies this deficiency by teaching a clamp assembly including two separate clamp elements where both clamp halves form a spherical cavity for retaining a spherical knob.

However, the object of O'Neal is to provide a mounting bracket for a handlebar crossbar that prevents the crossbar from moving or rotating with respect to the bracket that includes: a handlebar crossbar (12) having lugs (15); mounting brackets (22); and bolts (44). See, for example, Figure 3 of O'Neal. O'Neal discloses that the bolts (44) secure the lugs (15) of the crossbar (12) to the brackets (22) and thereby prevent moving or rotation of the

crossbar (12) with respect to the brackets (22). See, for example, column 3, lines 50-56 of O'Neal.

Because the intended purpose of the structure of O'Neal is to provide a mounting bracket for a handlebar crossbar that prevents the crossbar from moving or rotating with respect to the bracket, there is no motivation to combine O'Neal with the structure of Ueng to achieve the features recited in claim 1. Specifically, if the spherical knob of Ueng were combined with the crossbar of O'Neal, the crossbar of O'Neal would rotate.

Accordingly, Applicant submits that Ueng teaches away from intended purpose of the structure of O'Neal.

Further, the Office Action's conclusion of obviousness is based merely on improper hindsight. The courts have consistently held and the MPEP provides, that it is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the claimed combination would have been obvious. *In re Gorman*, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir, 1991) (emphasis added). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of

O'Neal with the teachings of Ueng. Although both references relate to attachments for vehicles, one of ordinary skill in the art of crossbrace assemblies for motorcycle handlebars would not look to a mirror assembly of an automobile to address secure attachment of a crossbrace assembly of a motorcycle handlebar. Importantly, the fact that O'Neal and Ueng disclose particular features that may be common to that of the claims is not enough to establish a *prima facie* case of obviousness under §103(a) and 2143.01(IV)). Saunders also fails to provide a motivation for combining the references. The Examiner is merely piece-mealing three references together to achieve the claimed features. Accordingly, there is no motivation to combine the applied references as alleged by the Office Action.

2) Ueng is not analogous art as defined by MPEP § 2141.01(a).

To rely on a reference for a rejection under 35 U.S.C. §103(a), the reference must be analogous prior art (MPEP §2141.01(a)). To qualify as analogous prior art, "the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). *See also, In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

The Office Action asserts that the clamps of O'Neal and Ueng are both related to the same field of endeavor, connections for attachments to vehicles. However, as argued at the personal interview, the motorcycle crossbrace clamp assembly of Applicant's specification and the pending claims, and the mirror assembly of Ueng are nonanalogous art, as they are not within the same field of endeavor. For example, the field of endeavor in Applicant's specification and the pending claims relates to clamping respective ends of a cross brace to a handlebar. In contrast, the field of endeavor of Ueng relates to a mirror assembly with a universal joint that allows an operator of an automobile to adjust the angular position of the mirror.

Furthermore, Ueng is not "reasonably pertinent to the particular problem with which the inventor was concerned." When determining whether a reference is reasonably pertinent to the particular problem with which the inventor was concerned, "the similarities and differences in structure and function" carry great weight. MPEP §2141.01(a), *Ellis*, 467 F.2d at 1372; see also *Clay*, 966 F.2d 656. Ueng is neither similar in structure nor similar in function to Applicant's invention as recited in the pending claims.

The mirror assembly of Ueng is functionally different from Applicant's claimed clamp assembly. The function of Ueng is to allow a mirror to be rotated in all directions. The mirror assembly of Ueng includes a mirror attached to a single lower-stem half (18) having a universal joint (31) that enables the lower-stem half (18) to rotate in all directions within a single bracket (20). See, for example, Ueng, column 2, lines 21-23 and 38-43 and Figure 1. However, the function of Applicant's motorcycle crossbrace clamp assembly is to allow a motorcycle handlebar crossbrace to be securely attached to a handlebar, i.e., prevent rotation. (page 4, line 18 of Applicant's specification). Applicant's specification and the pending claims include two clamps including two separate clamp elements for a handlebar crossbrace that prevent the crossbrace from moving or rotating with respect to the clamps. Thus, the mirror assembly of Ueng is not functionally similar to Applicant's motorcycle crossbrace clamp assembly.

As discussed above, the structure of Ueng is completely different from the structure of Applicant's motorcycle handlebar crossbrace clamp assembly. Specifically, both ends of the crossbrace of Applicant's clamp assembly are to be clamped. In contrast, the mirror assembly of Ueng provides that only one end of the lower-stem half (18) is being held in an adjustable manner. Thus, the mirror assembly of Ueng is not structurally similar to Applicant's motorcycle handlebar crossbrace clamp assembly.

Because Ueng is different and has no similarities in structure and function to Applicant's motorcycle handlebar crossbrace clamp assembly as recited in the pending claims, Ueng cannot reasonably be considered to be reasonably pertinent to the particular problem with which the inventor was concerned. Thus, in accordance with MPEP §2141.01(a), Ueng cannot be considered analogous art. Therefore, the rejections are improper and should be withdrawn.

As discussed above, these rejections are improper because 1) Ueng is not analogous prior art; and 2) the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, Applicant respectfully requests withdrawal of the rejections.

II. New Claim 4

Regarding new claim 4, as agreed by the Examiners, Applicant submits that the references, and in particular, Ueng, do not disclose or suggest all of the features recited in new claim 4. In particular, the applied references do not disclose or suggest, individually or in a permissible combination, "the part-circular recess of each clamp element being tapered so as to form a close fit with a corresponding tapering shape of the handlebar," as recited in independent claim 4. Allowance of claim 4 is respectfully requested.

III. Conclusion

In view of at least the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-4 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Request for Continued Examination

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